

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
	:	Examiner: Loan H. Thanh
Kieran P. MURPHY, ET AL.)	
	:	Group Art Unit: 3763
Application No.: 10/602,886)	
	:	
Filed: June 25, 2003)	Confirmation No.: 2271
	:	
For: PERCUTANEOUS SPINAL)	
CATHETER (As Amended)	:	June 30, 2006
)	

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SECOND REQUEST FOR NEW OFFICE ACTION

Sir:

Applicants again request a complete Office Action, to replace the defective December 30, 2005 Office Action.

The December 30, 2005 Office Action is fatally defective for at least the following reasons:

1. The Office Action fails to identify what features of Claims 31-35 are missing from the figures, as required by MPEP 608.02(d).
2. The Office Action fails to even address pending Claims 36-37.
3. The Office Action rejects Claims 31-35 under 35 U.S.C. § 112, first paragraph, stating “The only support applicant has is in paragraph 36.” The present

specification ends at paragraph [0029].

On January 5, 2006, Applicants filed a Request for Restated Office Action requesting that a new Office Action be issued. No response has been received.

Accordingly, Applicants again request that a proper, complete Office Action be issued to replace the defective December 30, 2005 Office Action.

Applicants provide the following limited response to the understandable portions of the December 30, 2005 Office Action, to aid the Examiner is preparing a new Office Action. Applicants submit that until a proper, complete Office Action is mailed, no extension of time fees are due for responding to the defective Office Action, although the Commissioner has authority to charge Deposit Account No. 50-1710 for any extension fees required to maintain the pendency of this application.

Limited Response

Claims 18-37 are pending in the application. Claims 18, 25, 31, and 37 are independent.

The drawings were objected to under 37 C.F.R. § 1.83(a) as allegedly not showing every feature of Claims 31-35. However, the Office Action does not specify which features are allegedly not shown. Applicants traverse this objection. Applicants submit that every feature of Claims 31-35 that is necessary for the understanding of the claimed subject matter (see 37 C.F.R. § 1.81) is depicted in Figs. 7-8.

Claims 31-35 were rejected under 35 U.S.C. § 112, first paragraph, for:

The combination of the elements with the functional language is not supported as originally filed or currently claimed. The only support applicant has is in paragraph 36. There a stylet is removed from the Tuohy needle not a guidewire. The guidewire is removed from the catheter.

First, Applicants do not understand what is meant by “The combination of the elements with the functional language is not supported as originally filed or currently claimed.” Claim 31 was not “originally filed.” If this rejection is maintained, please clarify this statement.

Second, Applicants point out that there is no paragraph 36 in the specification. The specification ends at paragraph [0029].

Third, Applicants do not understand the phrase “a stylet is removed from the Tuohy needle not a guidewire. The guidewire is removed from the catheter.” If this rejection is maintained, please clarify this statement.

Fourth, Applicants submit that the person of ordinary skill in the art would be readily enabled to make and use the invention, without undue experimentation, given the teachings of the specification and Drawings as filed. See, in particular, paragraphs [0024]-[0026] of the specification, in conjunction with Figs. 7-8.

Claims 18-30 were rejected as being unpatentable over Gross, Utterberg, and Karakelle, for the reasons noted at pages 4-6 of the Office Action. No art rejection has been made against any of Claims 31-37. Applicants traverse all art rejections.

In the Office Action, the Examiner referred Applicants to Gross, Column 8, lines 33-49; however, Gross only has 6 columns.

The Examiner states that Gross discloses a tapered catheter and refers Applicants to Figs. 6-8. However, these Figures (and the accompanying portions of the specification) relate to a needle 10, and not to a catheter. The only catheter discussed in Gross is catheter 34, which has no tapering. In fact, the needle 10 of Gross is rigid.

Likewise, the Examiner states that Utterberg discloses a tapered catheter and refers Applicants to Figs. 1-1a and 5-6. However, these Figures (and the accompanying portions of the specification) relate to a cannula 10, and not to a catheter. The only catheter discussed in Utterberg is catheter 82, which has no tapering. The cannula 10 of Utterberg is rigid.

On the other hand, Claims 18-30 claim a catheter, which is “A hollow flexible tube for insertion into a body cavity, duct, or vessel to allow the passage of fluids or distend a passageway.” <http://dictionary.reference.com/browse/catheter>. Accordingly, the claimed catheter of the present invention is nowhere disclosed or suggested by the cited art.

In view of the above, it is believed that this application is now in condition for allowance, and a Notice thereof is respectfully requested.

Applicants' undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 625-3507. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

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